

REMARKS

I. General Remarks

Claims 1, 2, 5, 7, 8, 11, and 12 have been amended herein. Claim 16 has been added as a new claim. Claims 3 was previously amended in the previously-filed preliminary amendment. Claims 1-16 are now pending in this application.

II. Remarks Regarding Claim Objections

A. Two Versions of Claim 12

The Examiner observed that two versions of claim 12 were inadvertently added by Applicant. Applicant acknowledges this inadvertent error and confirms the Examiner's assumption that the version of claim 12 that was filed on January 28, 2004 in the Supplemental Declaration for Reissue, is the version of claim 12 that Applicant intends to present for examination.

Accordingly, Applicant thanks the Examiner for disregarding the version of claim 12 that was filed in the Declaration for Reissue, dated August 18, 2000.

B. Claim 5

Claim 5 has been amended to address the Examiner's objection as to the word "strap."

C. Claim 7

Claim 7 has been amended to provide continuous subsections in claim 7 as suggested by the Examiner.

D. Claim 8

Claim 8 depends from claim 7. Claim 7 has been amended to provide antecedent basis for the terms "the fastener" and the flap" found in claim 8.

E. Claim 12

The word, "to," has been added to line 19 (of text) of claim 12 as suggested by the Examiner.

III. Remarks Regarding the 35 U.S.C. § 251 Rejection

Claims 1-15 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the

present reissue application is based. More specifically, the Examiner objects to the amendments to recite *a* fastening means (by deletion of references to *two* fastening means).

Accordingly, the claims have been amended to each recite at least two fasteners, but is not limited by the “means plus function format of 35 U.S.C. § 112, ¶ 6.

As provided in the Manual of Patent Examining Procedure, a reissue claim that recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation) may not be rejected under the recapture doctrine. *See* M.P.E.P. § 1412.02 I.C. (citing *Ex Parte Eggert*, 67 U.S.P.Q.2d 1716 (Bd. Pat. App. & Inter. 2003) (precedential)). Thus, when deciding what subject matter has been surrendered, one should look to the scope of the claims in the original patent’s prosecution *before* the relevant amendments thereof. As the key limitations are now present in the rejected claims and have been amended to be narrower than the claim scope *prior* to the relevant amendments referred to by the Examiner, this recapture rejection is no longer relevant to Applicant’s claim amendments.

IV. Remarks Regarding the 35 U.S.C. § 112 Rejections

A. Claim 7

Claim 7 has been amended to address the Examiner’s objection thereof.

B. Claim 8

Claim 7 has been amended to provide antecedent basis for the terms “the fastener” and the flap” in the claim in claim 8, which depends from claim 7.

V. Remarks Regarding the 35 U.S.C. § 102(b) Rejections

Claims 1, 12, and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,185,834 issued to Creper (hereinafter “Creper”).

To form a basis for a § 102 prior art rejection, a prior art reference must disclose each and every element as set forth in the claim. *See* MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). Applicant respectfully submits that Creper fails to teach each and every element as recited in amended independent claims 1 and 12, and correspondingly, in dependent claim 15.

In particular, Creper does not teach or suggest two fasteners of the types recited in amended independent claims 1 and 12, nor does Creper teach a belt where the enlarged front

portion has a height less than the enlarged back portion. Rather, as shown in Figures 1 and 2, the enlarged front portion is greater in height than the enlarged back portion. In particular, both claims 1 and 12 recite that "a second predetermined vertical height smaller than said first predetermined vertical height." Therefore, for at least these reasons, Creper fails to teach each and every limitation recited in Applicant's amended independent claims 1 and 12. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection as to Applicant's amended independent claims 1 and 12, and correspondingly, as to dependent claim 15.

VI. Remarks Regarding the 35 U.S.C. § 103(a) Rejections

A. Statements of Rejection and Cited Prior Art

Claims 5 and 13 stand rejected under 35 U.S.C. § 103(a) as being obvious over Creper in view of U.S. Patent No. 4,964,401 issued to Taigen (hereinafter "Taigen"). Claim 6 stands rejected under 35 U.S.C. § 103(a) as being obvious over Creper in view of U.S. Patent No. 1,600,027 issued to Wesland (hereinafter "Wesland"). Claims 7, 8, 11, and 14 stand rejected under 35 U.S.C. § 103(a) as being obvious over Creper in view of Taigen. Claim 10 stands rejected under 35 U.S.C. § 103(a) as being obvious over Creper in view of Taigen and further in view of Wesland.

Creper discloses a surgical belt useful in the treatment of back and abdominal injuries which can be quickly and easily secured in place and is adjusted to support and protect the injured area. The belt is designed to be "applied directly over a suitable dressing for a wound resulting from a surgical operation." Creper, col. 2, lines 5-10.

Taigen discloses a weightlifting belt with an elongated belt body incorporating a soft, foam rubber pad which faces the body of the user to provide comfortable, yet firm, support. The Taigen belt has an elongated rectangular shape, but fails to teach or suggest reduced side sections enlarged abdominal and back support areas.

Wesland discloses a climber's belt, which also fails to disclose reduced side sections and enlarged abdominal and back support areas.

The subject invention is directed to a belt specifically designed to provide back muscle support in combination with increased abdominal muscle support during strenuous activity. As stated in the preamble of independent claims, two important features of Applicant's support belt are as follows: 1) to provide both back and abdominal muscle support during strenuous activity and 2) to

provide support while providing a non-interfering fit with the skeletal structure of the ribs and hips of the wearer. In designing its support belt, Applicant recognized that a key aspect to providing optimum support is to provide a belt having a width that engages a greater portion of the abdominal and back walls and can be sufficiently tightened against these walls. If the width of the belt, however, is such that it also engages the ribs or hips of the wearer, the amount of tightening of the belt that can be achieved against the abdominal and back walls is reduced since the skeletal structure of the ribs and hips has a fixed circumference. Thus, prior art belts of a continuous width are either too narrow to provide maximum support to the abdominal and back walls or are too wide and interfere with the skeletal structure of the ribs or hips of the wearer so as to not allow the belt to be sufficiently tightened against the back and abdominal walls to provide optimum support and may be extremely uncomfortable.

Applicant's invention solves the problem by providing a support belt specifically designed to include enlarged abdominal and, back support areas and reduced side sections, which allows the belt to be sufficiently tightened to provide optimum support to both the back and abdominal walls. While the non-interfering fit of the reduced side sections provides ample clearance between the hips and ribs of the wearer for maximum comfort and mobility, the main purpose of this feature is to provide a belt with enlarged front and back support areas to provide improved support of the back and abdominal walls without encountering the skeletal structure of the ribs and hips of the wearer. Additionally, in Applicant's claimed belt, the enlarged front portion is of a height no greater than the height of the back portion.

The Examiner argues that it would have been obvious to combine the teachings of Creper and Taigen. Obviousness, however, cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or motivation, found in the cited prior art references, supporting the combination. *ACS Hospital Sys. Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984); *In re Geiger*, 815 F.2d at 688, 2 U.S.P.Q.2d at 1278 (Fed. Cir. 1987). Nothing in either Creper or Taigen remotely suggests a motivation for combining the features of both disclosures. Indeed, neither cited reference teaches or suggests a solution for providing maximum support of the abdominal and back walls during strenuous activity by providing a belt with enlarged abdominal and back support areas in

combination with reduced side areas forming a non-interfering fit with the skeletal structure of the ribs and hips of the wearer while at the same time supplying convenient fasteners as those recited in Applicant's claims.

Creper shows a surgical belt made of loosely woven canvas, or similar material, to be applied over dressing for a wound resulting from a surgical operation. While the surgical belt may include reduced side panels, Creper does not disclose or remotely suggest a support belt specifically designed to include enlarged abdominal and back support areas and reduced side sections which allow the belt to be sufficiently tightened to provide optimum support to both the back and abdominal walls during strenuous activity. In fact, the inclusion of reduced side panels is optional, as stated in the Creper, the "edges of the belt may be shaped as to accommodate the movement of the body of the wearer, being preferably, though not necessarily, concaved at the side portions 13 and 14 of the belt". (emphasis added) Col. 2, lines 10-14. Since the reduced sides are merely optional, Creper clearly does not recognize or teach the importance of this feature. In Applicant's invention, side clearance is an essential, critical part of the invention. Moreover, there is nothing to suggest that a solution for improving the support capacity of a weight lifting belt, such as Taigen, would be sought in the art for immobilizing bandages. Just as significantly, Creper teaches a belt where the back portion is of a lesser height than the front portion. See Fig. 2. In the foregoing invention as claimed, the enlarged front portion has a height no greater than the enlarged back portion. The reason for this is that while the front portion provides support to the abdominal cavity, it cannot be so large that it inhibits motion of the wearer, such as forward bending. Applicant notes that while this limitation has been present in the claims, it was never raised in the past as a claim limitation that distinguished over the prior art. Not only does Creper lack any teaching or suggestion of this feature, Creper teaches just the opposite, — namely an enlarged front portion that is greater in height than the enlarged back portion.

The solution to a problem, once known, may be obvious even when the recognition of the problem itself or of the source of the problem is not. Thus, the discovery of the source of a problem may result in a patentable invention despite the fact that the solution would have been obvious once the source of the problem was discovered. *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 U.S. 45 (1923). Applicant recognized that if the width of the belt is such that it also engages the ribs or hips of the wearer, the amount of tightening of the belt that can be

achieved between the abdominal and back walls is reduced since the skeletal structure of the ribs and hips have a fixed circumference and optimum support cannot be achieved. There is nothing in either Creper Taigen, or Wesland which teaches or recognizes the problem or the source of the problems solved by Applicant's invention.

Applicant respectfully submits that amended independent claims 1, 7, and 12, and claims 2-6, 8-11, and 13-15, depending therefrom, are patentable over the cited prior art. Therefore, it is respectfully requested that the Examiner withdraw the stated rejections as to claims 1-15 under 35 U.S.C. §103.

B. A Person of Ordinary Skill in the Art Would Not Have Been Motivated to Combine the Cited References to Arrive at Applicant's Specific Combination of Claimed Elements – Traversal Based on Secondary Considerations

Applicant respectfully traverses the § 103(a) rejections based on secondary considerations of non-obviousness. In view of these secondary considerations, Applicant respectfully requests reconsideration and further examination pursuant to 37 C.F.R. § 1.111. Applicant additionally requests allowance of the claims at an early date.

Applicant has previously presented evidence of secondary considerations in support of non-obviousness over the cited prior art in the prosecution leading to the issue of U.S. Patent No. 6,053,883 (the patent on which this reissue application is based). This earlier presentation of secondary considerations, filed March 29, 1996 eventually led to allowance of Applicant's claims over the cited prior art through an opinion of the Board of Patent Appeals and Interferences on June 3, 1999. Accordingly, Applicant resubmits the following evidence of secondary considerations: the earlier-filed Declaration, dated April 4, 1995 made by John Schiek (an officer of Assignee Schiek Sports, Inc.) addressing sales volume and competitor copying; an article by John Abdo advocating the novel features of the Applicant's invention; and drawings demonstrating the muscular and skeletal structure of the human body. Please note that the remarks below advancing the secondary considerations of Applicant's invention are substantially similar to the remarks earlier submitted by Applicant on March 29, 1996 in the original patent application. Applicant respectfully requests acceptance and consideration of the properly presented evidence submitted herewith. While the secondary consideration evidence is now several years old, the secondary considerations that existed at the time of the invention are what should be sued primarily in evaluating the invention under 35 U.S.C. § 103.

It is well established that objective evidence of nonobviousness, i.e. secondary considerations, is relevant in an inquiry under 35 USC § 103(a). *Graham v. John Deere Co.*, 383 US 1 (1966). Among these secondary considerations are commercial success, *Azko N. V. v. International Trade Commission*, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986); professional approval, *In re Wood*, 202 U.S.P.Q. 171 (CCPA 1979); copying, *Avia Group International, Inc. v. I.A. Gear California, Inc.*, 7 U.S.P.Q.2d 1548 (Fed. Cir. 1988); and laudatory statements by competitors, *Libbey-Owens-Ford Co. v. BOC Group Inc.*, 4 U.S.P.Q.2d 1097 (D.N.J. 1987).

1. Commercial Success

Turning first to commercial success, the following factors are relevant with respect to evidence of commercial success: 1) the product is a commercial success based on *relative* market share; 2) a nexus exists between the invention and commercial success; and 3) that the showing is commensurate in scope with the claims. (Paper No. 18, Page 7); *In re Thompson*, 192 U.S.P.Q. 275 (CCPA 1976). Attached as Exhibit A is a Second Declaration by the Assignee Schiek Sports, Inc. ("Assignee") addressing each of these requirements.

a) Relative Market Share

Since its introduction in 1991, sales of the invention have continued to rise even as sales in the overall support belt industry have declined. A primary difference between the invention and the support belts which are sold by the Assignee's competitors (excluding competitors' copies of the invention) is the contoured shape of the invention. As described in the Specification of the above-referenced patent application, the narrowing of the belt along its sides prevents the belt from overlaying either a portion of the wearer's rib cage, pelvic bone, or both. When *combined with a widening* of the belt at the front, intra-abdominal pressure is maximized. The Prior Art Belts do not teach or suggest that the best way to maximize intra-abdominal pressure is to encase the abdomen using a wide front section of the belt to overlay the front of the abdomen and narrower side sections of the belt to overlay the sides of the abdomen without interference from adjacent bone structures. Because of these product differentiations, the Assignee's market share has increased even though the support belt industry as a whole has been contracting and companies similar to the Assignee in size and market share have been closing. Taking into account lag time following its introduction, the Assignee's sales of the invention have increased 9% while industry sales of belts without the contoured features have decreased

over 51%. Therefore, not only has the Assignee enjoyed commercial success based on the sales of the invention, this success has come at a time when the rest of the support belt industry has been struggling.

The Assignee's market share is addressed in Paragraphs 6-10 of the Second Declaration. The Assignee's unit sales of the invention, as well as the Assignee's market share, have continued to increase since the introduction of the invention. Steadily increasing sales since 1991 are significant because the unit support belt sales of the industry as a whole have declined over 51% since 1993. The graph attached as Exhibit B to this Response and attached as Exhibit E to the Second Declaration best illustrates the success of the Assignee compared to the entire support belt industry. As is evident from the graph, in a period when the support belt industry as a whole, which sells primarily Prior Art Belts, has been contracting, the Assignee, which sells only supports belts of the present invention, has been enjoying healthy growth.

These sales figures become even more significant when the unit sales price of the invention sold by the Assignee is compared to the unit sales price of the Prior Art Belts. As addressed in Paragraph 9 of the Second Declaration, the Assignee's customer base is limited to the high end of the support belt market. As such, the Assignee's unit sales price of a belt in accordance with the invention is on average 70% higher than the unit sales price of industry support belts. In fact, in 1995, the Assignee's unit sales price was approximately \$26.53/belt, while the industry's unit sales price was \$13.00/belt, which is over a 104% difference in price. Even with a significantly higher unit sales price, however, the invention as sold by the Assignee continues to experience commercial success. In other words, as the industry as a whole has dropped its unit sales price per belt to encourage sales and stabilize market decline, the assignee has maintained a substantially higher unit sales price and has realized a growth in unit sales and market share, all of which is strong evidence of the commercial success of the invention.

b) Nexus

With respect to the nexus between the invention and the commercial success, the Second Declaration points out in Paragraph 21 that the invention has been well received by both consumers and market experts. In their praise of the invention, both groups focus on the novel features of the invention. For example, a Product Evaluation from the January 1992 edition of Midwest Muscle Bodybuilding Magazine concludes as follows:

"the design improvements have produced contours in the width of the side belt to increase mobility in the hip region, while adding width to the front for intra-abdominal support. The Inter-Abdominal Pressure Maximizer provides optimum coverage of the abdominal wall, in effect, tightening the spine from the inside. The modifications have allowed the powerlifters to push heavier squats, yet erase the belt pinch while dead lifting."

Another example of expert approval is found in the unsolicited article, entitled "Spinal Longevity" by John Abdo, referred to in the Second Declaration at Paragraph 21. After briefly describing the evolution and various functions of lifting and support belts, Mr. Abdo turns his discussion to the Applicant's invention. Specifically, beginning at the bottom of page 6 and continuing on page 7, the article states as follows:

"The latest advancement in belt technology is a belt that measures 4 3/4" at the small of the back to support the lumbar, tapers to 2 1/2" on the sides to avoid rubbing against the floating ribs, then flares back out to 4" on the frontal abdominal region. The only belt of this kind is manufactured by the Schiek corporation [Applicant] who have revolutionized the support belt industry.

The mechanics and benefits of the Schiek style belt are numerous. When this belt is worn the entire 360 degree circumference of the midsection is wrapped with support. At the rear, the normal lumbar curve is held in place while the obliques and abdominals squeeze inward and upward to hold up the rib-cage. This elongates and decompresses the spine whether you're attempting MAX resistance's in the weight room or jogging around your favorite course. If, and when, the rib cage collapses, inner organs including the heart and lungs have a limited amount of operational space to conduct the functions needed to carry out the activity at hand.

I have become such an advocate of the Schiek belt that I encourage everyone to wear one whenever engaged in uncomfortable situations. This includes those of you who have back pain when standing or sitting for extended periods of time like cashiers or secretaries. Shoveling snow, jogging, carrying around your infant, doing household chores, and even walking around a large shopping mall, are all activities in which gravitational stresses may contribute to back ailments." (emphasis added).

The Second Declaration also includes purchasers' responses to the invention. Again, the responses praise the novel features of the invention. Cumulatively, these evaluations by experts in the support belt industry, as well as support belt customers, are strong evidence that the

commercial success of the invention is due to the novel features of the invention as opposed to other extraneous factors such as trade name or trademark recognition, advertising, packaging with other products, or distribution networks.

At Paragraph 11 of the Second Declaration, the Assignee provides advertising expenses associated with the sale of the invention. As can be expected of a small company which relies on a single product, initial advertising expenses were relatively small, i.e., 2.46% of net sales in 1991. As unit sales of the invention began to increase, the Assignee was able to devote more resources to advertising. Even with increased sales, however, the Assignee's advertising expenses have remained low, increasing to only 6.10% of net sales in 1995. Clearly, this increase is insignificant when the commercial success of the invention and the trend in the overall market are considered. Specifically, as discussed above, unit sales of the overall support belt market have dropped over 51% since 1993. The paper titled "Pack Belts Market Analysis and Report" by John Alden Associates (attached as Exhibit D to the Second Declaration) and associated articles indicate that in 1994 and 1995, the net sales of the support belt industry were approximately \$54,000,000 and \$52,000,000, respectively. However, even with advertising expenditures in the millions of dollars (based on the net sales figures for the overall industry), the industry has not been able to reverse the downward trend of the support belt market. In that the industry as a whole has not been able to reverse the downward trend of the market with millions of dollars of advertising, it is unlikely that the Assignee's expenditure of approximately \$46,000 in 1994 and \$66,000 in 1995 would account for the Assignee's current success. Therefore, the Assignee's advertising expenditures have not had a significant effect on the commercial success of the invention. In other words, the commercial success of the invention has been well beyond the effect of the Assignee's promotional efforts. *Windsurfing Intemation al, Inc. v. F Incorporated*, 228 U.S.P.Q.2d 562 (Fed. Cir. 1956), *cert. denied*, 477 U.S. 905 (1956).

The same is true of trade name and trademark recognition. As stated in Paragraph 14 of the Second Declaration, the Assignee is a very small company that targets its product, the invention, at a very small segment of support belt consumers. Because of its small size and very limited product line, the Assignee's name is not widely known. Thus, it is unlikely consumer's who purchased the invention from the Assignee were motivated to do so because of trade name or trademark recognition.

Similarly, as stated in Paragraph 13 of the Second Declaration, the invention is not packaged or sold with other products. Therefore, sales of the invention are not attributable to tying with other products.

The Assignee has also indicated in Paragraph 5 of the Second Declaration that the Assignee's distribution network is very small, selling either directly to consumers or through a limited number of specialty stores. The Assignee does not market its products through large national retail chains. Therefore, the commercial success of the invention cannot be attributed to the Assignee's distribution network.

In that the Applicant has shown that there are no extraneous factors that have affected the commercial success of the invention, a proper conclusion would be that the success of the invention is based solely on the invention's own merits. Such a conclusion is supported by the comments and praise that the invention has generated from experts and consumers in the support belt industry.

c) Scope of Claims

Turning to the final evidentiary requirement for commercial success, Paragraphs 4 and 15 of the Second Declaration indicate that the commercial success is commensurate with the scope of the claims. Specifically, the 1991 copyrighted advertisements, as well as the 1992 advertisement, show the invention as it has been marketed by the Assignee. (Attached as Exhibit C of this Response and Exhibit A of the Second Declaration). The drawings in these advertisements are substantially the same as Figures 1 and 2 of the Disclosure. (Attached as Exhibit D of this Response for the Examiner's convenience). Because the features of the independent claims herein are all depicted in Figures 1 and 2 of the Disclosure, and because the invention as marketed and sold by the Assignee is the same as the invention described and shown in the Disclosure, the commercial success of the invention is commensurate with the scope of the claims.

2. Copying by Assignee's Competitors

"Copying the claimed invention, rather than one within the public domain, is indicative of non-obviousness." *Windsurfing International Inc. v. AMF Inc.* at 565. At Paragraphs 16-20 of the Second Declaration, copying of the invention by the Assignee's competitors is addressed. The Assignee began marketing and selling the invention in August 1991. Initially, the Assignee's

competitors down-played the invention and its novel features. However, by 1993 as unit sales were beginning to drop off in the support belt market, the Assignee's competitors began to copy the invention.

As stated in Paragraph 17 of the Second Declaration, the Assignee's largest competitors who have copied the invention include the following: OKI Manufacturing Co. (Altus Athletics), Altus, OK, 73522, Model CF-5 (ECB-5); Ergodyne, 1410 Energy Park Drive, Suite 1, St. Paul, MN 55108, Model ProFlex 1500; Valeo, Waukesha, Wisconsin, Model VCR and VCC; and Grizzly Sporting Goods, a Division of Custom Leather Canada Ltd., 451 Philip Street, Waterloo, Ontario, Canada, N2L3K2, Model 847104.

Ergodyne was the first to copy the invention. Ergodyne's copy of the invention was first advertised in 1993 under the ProFlex 1500 name. As part of its advertisement, Ergodyne states that the contoured shape of the ProFlex 1500 "revolutionizes the weight lifter style belt." Although Ergodyne's advertisement appeared in 1993, most of the Assignee's other competitors, such as OKI and Valeo, did not begin to copy and advertise the invention until 1994-1996. For example, in the February 1995 issue of Occupational Health & Safety magazine, OKI advertised a copy of the invention as a "NEW MODEL", while in the Spring 1995 Conney catalog, Ergodyne is still referring to the ProFlex 1500 Back Support as "revolutionary." In January 1996, Valeo advertises a Contoured Pack Support as a "NEW PRODUCT" in the Personal & Industrial Safety section of the Lab Safety Supply catalog, while in the Conney catalog of Spring 1996, OKI continued to advertise the Contoured Back Support as a "NEW" product. In each case, the products that these competitors have deemed "new and revolutionary" in the mid-1990's were merely copies of the invention that the Assignee has been selling since August 1991.

It is clear from "Back Belts Market Analysis and Report" that most of these competitors are multi-million dollar companies who were in business long before the Assignee entered the support belt market. However, it was not until two years after the Assignee's introduction of the invention to the market that these competitors began to copy and sell the invention. Prior to that time, these competitors had only marketed and sold the Prior Art Belts. It is also apparent from the advertisements included in Exhibit H of the Second Declaration that these copies were and are substantially the same as the invention which has been sold by the Assignee since 1991 (per the copyrighted advertisements) and claimed in the above-referenced patent application. The

Applicant respectfully suggests that (1) copying by the Assignee's competitors *several years after the* Assignee began to sell the invention (2) coupled with statements by those competitors that the copies are "new and revolutionary" is very strong evidence of nonobviousness and should be afforded considerable weight in a nonobviousness determination.

3. Professional Approval

Expressions of approval by industry experts are additional factors bearing on the question of obviousness. *See United States v. Adams*, 148 U.S.P.Q. 479 (1966). Widespread and uniformly favorable acceptance by the trade, including laudatory articles in trade publications, as well as marketing of the invention by others, provides additional support for a conclusion of nonobviousness. *See Saf-Gard Products, Inc. v. Service Parts, Inc.*, 190 U.S.P.Q. 455 (9th Cir. 1976). As previously stated, the article entitled "Spinal Longevity" by John Abdo was an unsolicited response to the invention. The article favorably discusses the features of the invention that the Applicant believes are novel, i.e., the contoured sides combined with the widened front to maximize intra-abdominal pressure, and distinguishes the invention from the prior art. The same is true of the Product Evaluation appearing in the January 1992 issue of Midwest Muscle Bodybuilding Magazine, which is also specifically referenced in the Second Declaration, Paragraph 21.

Other expressions of approval from the industry can be found in the following trade magazine literature which are made a part of the Second Declaration in Exhibit J:

- (1) October 1995 issue of Muscle Fitness, "Belts, Gloves & Straps" by Marty Gallagher: "A growing number of experts point out that better intra-abdominal pressure is obtained with a belt with wide frontage, which these [Prior Art] belts lack."
- (2) October 1995 issue of Ironman: "I told John Schiek that I would give his product a plug in this issue, so here it is; but to be frank, these are damn good belts!"
- (3) NSGA Retail Focus: "I could see it [the Schiek belt] was an idea whose time has come..."

"An evaluation of a claimed invention performed by an impartial, qualified third party is a valuable indication of the nonobviousness of an invention." *In re Wood and Eversole*, 202 U.S.P.Q. 171 (CCPA 1979). As such, the Applicant submits that the reaction of the experts in the

field has been positive, focusing on the novel aspects of the invention, and that this expert reaction is indicative of the invention's nonobviousness.

4. Laudatory Statements by Competitors

Finally, laudatory statements by competitors are also probative of nonobviousness. In an action seeking to have a patent declared invalid, the district court found that prior praise by the party seeking to have the patent declared invalid was strong evidence of nonobviousness. *Libbey-Owens-Ford v. BOC Group, Inc.*, 4 U.S.P.Q.2d 1097 (D.N.J. 1987). With respect to the Applicant's invention, the Second Declaration establishes in Paragraph 18 that the Assignee's competitors such as Ergodyne, the largest support belt manufacturer in the industry, has continuously touted (in its own advertisements) the design of the invention to be "revolutionary." And, Altus (OK1) states in their point-of-sale hangtag associated with their copy of the invention: "[u]nfortunately most belts---while effective for weightlifters---have never precisely fit the shape of the human body ...until now."

As pointed out in the previous section, widespread and uniformly favorable acceptance by the trade, including marketing of the invention by others, provides additional support for a conclusion of nonobviousness. *See Saf-Gard Products, Inc. v. Service Parts, Inc.*, 190 U.S.P.Q. 455 (9th Cir. 1976). The Second Declaration and evidence submitted therewith overwhelmingly establishes widespread and uniformly favorable acceptance of the invention by the Assignee's competitors. These competitors, including the largest and presumably the most sophisticated, have all concluded that the novel features of the invention enhance the state of the art of support belts. These conclusions can be found not only in direct laudatory statements made by the Assignee's competitors, but also implicitly in the adoption and widespread sale of the invention by the Assignee's competitors.

C. Conclusion

The Examiner has rejected the claims under 35 U.S.C. § 103(a) as being obvious in light of the cited prior art. None of the cited references, alone or in combination, teach or suggest each and every element recited in the claims. This is particularly true with regard to an enlarged portion that is no larger than the enlarged back portion. Notwithstanding the foregoing, one factor in determining obviousness is secondary considerations. Among these secondary considerations are (1) the commercial success of the invention, (2) copying of the invention by

others, (3) praise from industry experts, and (4) laudatory statements by competitors. It is well established that commercial success, *on its own*, is a strong factor favoring non-obviousness. *Simmons Fastener Corp. v. Illinois Tool Works, Inc.*, 222 U.S.P.Q. 774 (Fed Cir. 1984), *cert. denied*, 471 US 1065 (1985). The Applicant has presented considerable evidence that the invention has proven to be a commercial success, allowing the Assignee's sales to grow when sales in the rest of the support belt market have substantially decreased. The Applicant has demonstrated that this commercial success can only properly be attributed to the novel merits of the invention, and that other factors have had little or no effect on the commercial success of the invention. The Applicant has also shown that the product which has been commercially successful is the same as the invention recited in the claims of the above-referenced application. Therefore, the Applicant has conclusively established each of the elements necessary in a showing of non-obviousness based on an inventions commercial success. As such, the Applicant respectfully requests the withdrawal of the Examiner's rejections under 35 U.S.C. § 103(a).

Furthermore, in addition to the strong evidence of non-obviousness based on commercial success of the invention, the Applicant has also provided substantial evidence of copying of the Applicant's invention by competitors of the Applicant's Assignee. The Applicant has demonstrated that the Assignee introduced the invention to the market in 1991, long before the Assignee's competitors began to copy and market the invention. Very probative of this issue is the fact that these competitors labeled the invention as new and a breakthrough in 1995 and 1996.

Finally, as additional evidence of non-obviousness, the Applicant has also presented favorable responses and evaluations from different levels of the support belt industry, including experts, trade magazine reviews, competitors, and consumers.

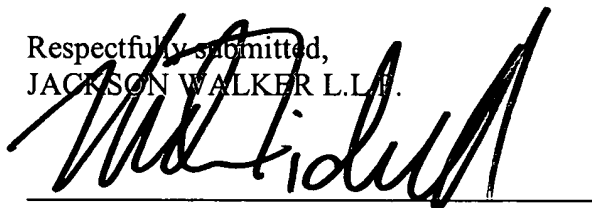
In conclusion, the Applicant has presented several different factors which, *individually*, provided substantial evidence of non-obviousness. *Cumulatively*, this evidence overwhelmingly establishes that the invention sought to be patented by the Applicant is non-obvious. Therefore, Applicant respectfully requests that claims 1, 7, and 12 be allowed and that dependent claims 2-6, 8-11, and 13-15, correspondingly, also be allowed.

SUMMARY

A check in the amount of \$325.00 is enclosed herewith (\$225 for a two month extension of time and \$100 for an excess claims fee for one independent claim in excess of three). As the shortened statutory period for reply ends on June 17, 2006, the two month time extension extends the period for reply up to and including August 17, 2006. Authorization is hereby given to charge Deposit Account No. 10-0096 for any deficiency of fees.

If the Examiner has any other matters which pertain to this Application, the Examiner is encouraged to contact the undersigned to resolve these matters by Examiner's Amendment where possible. A prompt examination and allowance of the pending claims is earnestly solicited.

Respectfully submitted,
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CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited on the date shown below with the United States Postal Service, with sufficient postage as First Class Mail (37 CFR 1.8(a)), in an envelope addressed to Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450.

Date: August 17, 2006



Renee Treider